

## **REMARKS**

Applicant would like to thank the Examiner for the careful consideration given the present application.

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,543,637 to Osborn (hereinafter Osborn) in view of U.S. Patent 5,745,565 to Wakefield (hereinafter Wakefield). For the following reasons, the Examiner's rejection is traversed.

Osborn discloses an adapter for adapting a conventional cup holder to hold a wide arrangement of containers. The adapter also provides for a removable insert which can be used to further adapt the adapter to accommodate various container sizes. The lower body portion of the insert may include one or more elongate slots which extend upwardly from a lower edge so as to form a compressible body portion. A rib may extend along the free edges of elongate slots to reinforce the cylindrical wall. The adapter and insert may also include elongate slots which allow for the passage of a cup handle.

Wakefield discloses a combination cup and cellular phone holder. Connected to and integral with a beverage or cup holder is a cellular phone or portable communication unit holder connected by a bridging member, all of which may be cast in an integral form of a suitable material such as a thermoplastic rubber. A foam rubber cushion may be provided in the bottom of the beverage holder and may include a slot for receiving the bottom of a cellular phone in those situations where the cellular phone is inserted into the beverage holder. A tapered insert may be positioned into the interior

of the cup holder proximate to the bottom of the cup holder and secured to a weighted bottom member.

Regarding claim 1, there is no motivation or suggestion in the art of record to combine the references in the manner proposed by the Examiner. The Examiner states that cup holders can hold phones, as shown by Wakefield and, thus, Osborn can be modified to hold a phone. The Examiner further states that whether or not the features of the secondary reference may be bodily incorporated into the primary reference is not determinative of the obviousness of making the proposed combination. However, Applicant respectfully states that there can be no suggestion or motivation to combine if one of the primary functions of the primary reference is defeated by incorporating the relevant teachings of the secondary reference.

In this case Wakefield does not simply teach dropping a phone into a cup holder, but rather holding the phone using a circular resilient member (20 or 120) in combination with either a slotted cushion 13, tapered insert, or spring 80. The resilient member is held by a retaining rim. Osborn, on the other hand teaches slots, not for viewing purposes, but to accommodate cup handles. As a result, these slots must remain open at their upper ends so a cup handle may be inserted and removed from the cup holder. To maintain these slots in a combination of Wakefield and Osborn, the resilient member and retaining rim would have to be split or broken, thus, defeating the structural integrity of these elements. Alternatively, to maintain the integrity of the resilient member and rim, the slot could not remain open at the top. Because loss of the function of the resilient member/rim or handle slots would be critical to the function of the devices a phone holder or cup holder, such a combination of teachings from the

references would not be motivated. Thus, such a combination of teachings is not obvious.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 in view of the combination of Wakefield and Osborn.

Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Wakefield and further in view of U.S. 6,263,080 to Klammer et al. (hereinafter Klammer).

Klammer discloses a holding device for the clamping accommodation of a telephone unit. The unitary holding device is narrow and includes a slotted bottom for the passage of a power cord.

Regarding claim 3, as previously stated, motivation is lacking to combine the Osborn and Wakefield references. Further, there is no motivation or suggestion in the art to combine the Wakefield and Klammer references. These references are directed toward solving different problems. Wakefield provides a cup holder and phone holder combination. As with most vehicle cupholders, if a chamber is part of the holder, that chamber is sealed because there is the potential for beverages to be spilled therein. When such a chamber is sealed, it is easier to clean out spills which would otherwise leak onto the vehicle below. Klammer is, alternatively, directed toward providing a phone holder where the phone can be moved between different positions. The present application provides the only motivation for making such a combination where a cupholder includes an opening in the bottom thereof. Reconsideration and withdrawal of the rejection of claim 3 is respectfully requested.

Regarding claim 4, even if the references were combined in the manner

proposed by the Examiner, the present invention would not result. As stated by the Examiner, outwardly extending ears that snap fit through openings in an outer member are not taught. Applicant does not agree that a snap fit is the equivalent to a friction fit. Friction fit joints are subject to conditions within a vehicle such as humidity, and the presence oil (e.g. from human skin) or other matter (e.g. spilled beverages). A snap fit is much more secure than a friction fit. Because further modifications of the combination of references would be required to teach the claimed invention, reconsideration and withdrawal of the rejection of claim 4 is respectfully requested.

Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Wakefield, further in view of Klammer and further in view of U.S. 6,084,963 to Hirai et al. (hereinafter Hirai).

Hirai is directed to a phone holder system that includes a single outer casing and a set of inner casings. The outer dimensions of the inner casings match the inner dimensions of the outer casing to provide a secure fit therebetween. Each inner casing has a different inner dimension to match the shape of one of a number of different cell phone types. Thus, when a different size of cell phone needs to be stored, the inner casing is simply swapped with a different inner casing from the set.

Regarding claims 5 and 6, as previously stated, there is no motivation in the art to combine the Osborn and Wakefield references and no motivation to combine the Wakefield and Klammer references. Hirai does not cure this deficiency in motivation. For these reasons, reconsideration and withdrawal of the rejection of claims 5 and 6 is respectfully requested.

Claims 7-9 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable

over Osborn in view of Wakefield and further in view of U.S. 5,848,820 to Hecht (hereinafter Hecht). For the following reasons, the Examiner's rejection is traversed.

Hecht discloses a pivotable rear seat center cushion assembly with a utility compartment. The utility compartment includes a cupholder that is pivotally connected within the utility compartment for movement between a stored position, and a use position in which the cupholder is suspended above, or rests against a user surface of a pivotable tray which is also part of the utility compartment. Hecht discloses a phone held within the center cushion, below the location of the cupholder and pivotable tray.

Regarding amended claim 7, even if the references were combined in the manner proposed by the Examiner, the present invention would not result. Neither Hecht, nor the combination of Osborn, Wakefield and Hecht teach or suggest "an open topped outer member that is adapted to be releasably secured to a panel assembly", as required. Hecht teaches a panel 26 that is movable between open and closed positions, and further teaches a cupholder 36 that is movable between vertical and horizontal positions. However, the cupholder itself is not adapted to be releasably secured to the panel 26. Neither Osborn, nor Wakefield cures the deficiencies of Hecht in this regard because Osborn and Wakefield do not disclose movable panels.

Additionally, as stated above, the combination of the Osborn and Wakefield references is not proper. For this reason, reconsideration and withdrawal of the rejection of claim 7 is respectfully requested.

Regarding claim 8, even if the references were combined in the manner proposed by the Examiner, the present invention would not result. Claim 8 requires a phone holding assembly wherein an outer member includes a series of mounting tabs

that are releasably secured within openings in a panel assembly. Hecht teaches a cupholder and tray, however, the cupholder does not include any openings except those into which beverage containers may be placed. The tray does not include any openings. Further, none of the cited references Osborn nor Wakefield, nor the combination thereof teach or suggest mounting tabs on an outer member, as required. As previously stated, Osborn and Wakefield teach elements that are held by friction within holders. The resilient members 48 taught by Wakefield are not tabs that are releasably secured within openings in a panel assembly. Thus, the proposed combination does not teach openings into which mounting tabs may be secured. Reconsideration and withdrawal of the rejection of claim 8 is respectfully requested.

Regarding claim 9, as previously stated with regard to claim 1, the Osborn and Wakefield references are not properly combinable. Hecht does not add to the art in a way that motivates combining these references. Reconsideration and withdrawal of the rejection of claim 9 is respectfully requested.

Claim 14 depends from claim 7, which is believed to be allowable for the reasons stated above. Reconsideration and withdrawal of the rejection of claim 14 is respectfully requested.

Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Wakefield and in view of Klammer and Hecht. For the following reasons, the Examiner's rejection is traversed.

Claim 10, like claim 3, requires inner and outer members that include a bottom wall that has an opening through which a power cord of a phone extends. As previously stated neither Osborn nor Wakefield teach or suggest a phone holder with openings.

Further Klammer is not properly combinable with Wakefield or Osborn. Hecht does not teach any adapter for receiving phones that includes an open bottom and so, does not teach toward the claimed invention, nor remedy the deficiencies in the art such that a combination of the other stated references is motivated. Reconsideration and withdrawal of the rejection of claim 10 is respectfully requested.

Claim 11, like claim 4, requires an inner member having outwardly extending ears that are snap fit through openings in an outer member. Osborn and Wakefield teach a friction fit between an outer member and an inner member. Klammer does not cure the deficiencies of Osborn and Wakefield. Hecht does nothing to cure the deficiencies of the cited art as Hecht does not teach or suggest any adapter utilizing ears or openings. Reconsideration and withdrawal of the rejection of claim 11 is respectfully requested.

Claims 12 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Wakefield and further in view of Klammer, Hirai and Hecht. For the following reasons, the Examiner's rejection is traversed.

Claims 12 and 13 depend directly or indirectly from claim 11 which is believed to be allowable for the reasons stated above. Hirai, which was not cited against claim 11, does nothing to cure the deficiencies of the references cited against claim 11. Reconsideration and withdrawal of the rejection of claims 12 and 13 is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is

invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. HRA-12807.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK LLP

By           /jab/            
James A. Balazs, Reg. No. 47401

4080 Erie Street  
Willoughby, Ohio 44094-7836  
(216) 566-9700